

REMARKS

This Amendment is submitted in response to the Office Action dated September 19, 2006. In the Office Action, the Patent Office rejected Claims 1-6, 13-20, 27 and 31 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Additionally, the Patent Office objected to the specification for failing to provide proper antecedent basis for the claimed subject matter.

Further, the Patent Office rejected Claims 1, 2 and 4 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,334,218 to *Johnson*; and rejected Claims 1-5, 7, 9-17, 19, 21-28, 30-33, 35-39, 41 and 42 under 35 U.S.C. §102(b) as being anticipated by International Publication No. WO 00/61065 to *Dussere*. Moreover, the Patent Office rejected Claims 6, 8, 20, 29, 34 and 40 under 35 U.S.C. §103(a) as being unpatentable over *Dussere* in view of U.S. Patent No. 3,669,117 to *Herbst*; rejected Claim 18 under 35 U.S.C. §103(a) as being unpatentable over *Dussere* in view of U.S. Patent No. 4,688,571 to *Tesler*; rejected Claims 43-45 under 35 U.S.C. §103(a) as being unpatentable over *Dussere* in view of U.S. Patent No. 5,810,000 to *Stevens*; and rejected Claim 46 under 35 U.S.C. §103(a) as being unpatentable over *Dussere* in view of *Stevens* and further in view of *Herbst*.

By the present Amendment, Applicant amended Claims 1, 6, 7, 10, 13, 14, 16, 18, 21, 24-26, 28, 29, 31-37 and 43-46. Applicant

asserts that the amendments to the claims and the remarks that follow overcome the objection and rejections made by the Patent Office and place the application in condition for allowance. Notice to that effect is requested.

With respect to the rejection of Claims 1-6, 13-20, 27 and 31 under 35 U.S.C. §101, Applicant respectfully submits that the rejection has been overcome by the amendment to independent Claims 1, 6, 13, 14, 16, 18 and 31 and for the reasons that follow.

In the Office Action, the Patent Office asserts:

Each of these claims includes either direct references or dependent references to elements of the claimed device contacting or oriented relative to portions of the user's body.

In response to the rejection, Applicant amended Claims 1, 6, 13, 14, 16, 18 and 31 to remove any reference to non-statutory subject matter from the claims. Applicant submits that the amendment to Claims 1, 6, 13, 14, 16, 18 and 31 overcomes the rejection by the Patent Office. Notice that effect is requested.

The Patent Office objected to the specification for failing to provide proper antecedent basis for claimed subject matter. More specifically, the Patent Office asserts:

Correction of the following is required: the specification does not provide antecedent basis for the shield being constructed from a light-absorbent material.

In response to the objection, Applicant amended Claim 18 to remove reference to the shield being constructed from a light-absorbent material from the claims. Applicant submits that the

amendment to Claim 18 overcomes the objection by the Patent Office. Notice that effect is requested.

In the Office Action, the Patent Office rejected Claims 1, 2 and 4 under 35 U.S.C. §102(b) as being anticipated by *Johnson*. More specifically, the Patent Office alleges that:

Johnson discloses a pacifier having a shield 20, a u-shaped shelf 28 and a bulb 14. The second end of the bulb extends downward relative to the first end due to its enlarged bulbous shape.

Independent Claim 1, as amended, requires that the top side of the shelf is planar and flat with respect to the bottom side of the shelf between the first side of the shelf and the second side of the shelf and from the first end of the shelf to the second end of the shelf.

Johnson merely discloses an infant pacifier/teether having a nipple member with a bulbous forward portion and a rearward portion. The rearward portion extends forwardly from an enlarged diameter shield. A handle is affixed to the rearward surface of the shield and a semi-circular teething member extends forwardly of the shield adjacent the nipple member. The teething member is sized and configured to conform to the shape of the alveolar ridge of an infant.

Nowhere does *Johnson* disclose that the top side of the shelf is planar and flat with respect to the bottom side of the shelf between the first side of the shelf and the second side of the

shelf and from the first end of the shelf to the second end of the shelf as required by Claim 1.

Under 35 U.S.C. §102(b), anticipation requires that a single reference discloses each and every element of Applicant's claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d. 1241, 1245 (Fed. Cir. 1986). Moreover, anticipation is not shown even if the differences between the claims and the reference are "insubstantial", and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d. 707, 716, 223 USPQ 1264, 1270 (Fed. Cir. 1984).

Since *Johnson* fails to disclose the elements specifically defined in amended independent Claim 1, Applicant asserts that the rejection of Claims 1, 2 and 4 under 35 U.S.C. §102(b) has been overcome and should be withdrawn. Notice to that effect is requested.

Further, the Patent Office rejected Claims 1-5, 7, 9-17, 19, 21-28, 30-33, 35-39, 41 and 42 under 35 U.S.C. §102(b) as being anticipated by *Dussere*. More specifically, the Patent Office alleges that:

Dussere discloses a pacifier having a ring 60 attached to a shield 50, a shelf 40 and a bulb 20. As shown in fig. 10a, there also exists two portions near the bottom which project back and down and which constitute the claimed lingual tabs. The walls of the shelf are spaced from the shield due to the spacer 70. The dental arches rest on the shelf.

Independent Claim 1, as set forth above, requires that the top side of the shelf is planar and flat with respect to the bottom side of the shelf between the first side of the shelf and the second side of the shelf and from the first end of the shelf to the second end of the shelf.

Independent Claim 7, as amended, requires that the shelf has a width defined between an upper side of the shelf and a lower side of the shelf wherein the width at the first end of the shelf and the second end of the shelf is thicker than the width at the midline of the shelf.

Independent Claim 14, as amended, requires that the thickness of the shelf between the top side of the shelf and the bottom side of the shelf is uniform and continuous between the first side of the shelf and the second side of the shelf and from the first end of the shelf to the second end of the shelf.

Independent Claim 21, as amended, requires a first thickness located between the first end of the shell and the second end of the shell wherein the shelf has a second thickness located at the depression of the first end of the shelf and the second end of the shelf wherein the second thickness of the shelf is greater than the first thickness of the shelf and further wherein the first side of the shelf and the second side of the shelf are bulbous.

Independent Claim 32, as amended, requires that the first area on the top side of the shelf defines a first depression on the top

side of the shelf wherein the first area and the first depression extend from the first end of the shelf to the second end of the shelf. Additionally, Claim 32 requires that the second area on the bottom side of the shelf defines a second depression on the bottom side of the shelf wherein the second area and the second depression extend from the first end of the shelf to the second end of the shelf. Further, Claim 32 requires that the shelf has a first thickness between the top side of the shelf and the bottom side of the shelf at the first side of the shelf and the second side of the shelf wherein the shelf has a second thickness between the first depression on the top side of the shelf and the second depression on the bottom side of the shelf wherein the second thickness is less than the first thickness and further. Moreover, Claim 32 requires that the first side and the second side are bulbous.

Independent Claim 37, as amended, requires that the depression on the top side of the shelf and the bottom of the shelf extends from the first end of the shelf to the second end of the shelf. Further, Claim 37 requires that the first side of the shelf and the second side of the shelf have a first thickness defined between the top side of the shelf and the bottom side of the shelf wherein the shelf has a second thickness at the depression defined between the top side of the shelf and the bottom side of the shelf wherein the second thickness is less than the first thickness. Moreover, Claim

37 requires that the shelf is made from a material which is locatable in a dark environment.

Dussere merely discloses a teat for an infant or child having a plate with arcades arranged thereon and defining a biting plane whereby the plate is limited at the front by a buccal screen. The buccal screen which is located on at least one arcade halts and the plate is joined to protruding means towards the front outside the mouth. The treat has a nipple that protrudes from the rear of the plate whereby the nipple faces the rear part of the tongue when the teat is in operation in the mouth of the infant or child to cooperate with the mouth and palate for stimulating a movement similar to feeding.

Nowhere does *Dussere* disclose that the top side of the shelf is planar and flat with respect to the bottom side of the shelf between the first side of the shelf and the second side of the shelf and from the first end of the shelf to the second end of the shelf as required by Claim 1. Nowhere does *Dussere* disclose that the shelf has a width defined between an upper side of the shelf and a lower side of the shelf wherein the width at the first end of the shelf and the second end of the shelf is thicker than the width at the midline of the shelf as required by Claim 7.

Nowhere does *Dussere* disclose that the thickness of the shelf between the top side of the shelf and the bottom side of the shelf is uniform and continuous between the first side of the shelf and

the second side of the shelf and from the first end of the shelf to the second end of the shelf as required by Claim 14. Nowhere does *Dussere* disclose a first thickness located between the first end of the shelf and the second end of the shelf wherein the shelf has a second thickness located at the depression of the first end of the shelf and the second end of the shelf wherein the second thickness of the shelf is greater than the first thickness of the shelf and further wherein the first side of the shelf and the second side of the shelf are bulbous as required by Claim 21.

Nowhere does *Dussere* disclose that the first area on the top side of the shelf defines a first depression on the top side of the shelf wherein the first area and the first depression extend from the first end of the shelf to the second end of the shelf as required by Claim 32. Further, nowhere does *Dussere* disclose that the second area on the bottom side of the shelf defines a second depression on the bottom side of the shelf wherein the second area and the second depression extend from the first end of the shelf to the second end of the shelf as required by Claim 32. Still further, nowhere does *Dussere* disclose that the shelf has a first thickness between the top side of the shelf and the bottom side of the shelf at the first side of the shelf and the second side of the shelf wherein the shelf has a second thickness between the first depression on the top side of the shelf and the second depression on the bottom side of the shelf wherein the second thickness is

less than the first thickness as required by Claim 32. Moreover, nowhere does *Dussere* disclose that the first side and the second side are bulbous as required by Claim 32.

Nowhere does *Dussere* disclose that the depression on the top side of the shelf and the bottom of the shelf extends from the first end of the shelf to the second end of the shelf as required by Claim 37. Further, nowhere does *Dussere* disclose that the first side of the shelf and the second side of the shelf have a first thickness defined between the top side of the shelf and the bottom side of the shelf wherein the shelf has a second thickness at the depression defined between the top side of the shelf and the bottom side of the shelf wherein the second thickness is less than the first thickness as required by Claim 37. Moreover, nowhere does *Dussere* disclose that the shelf is made from a material which is locatable in a dark environment.

Since *Dussere* fails to disclose the elements specifically defined in amended independent Claims 1, 7, 14, 21, 32 and 37, Applicant asserts that the rejection of Claims 1-5, 7, 9-17, 19, 21-28, 30-33, 35-39, 41 and 42 under 35 U.S.C. §102(b) has been overcome and should be withdrawn. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claims 43-46 under 35 U.S.C. §103(a) as being unpatentable over *Dussere* in view of *Stevens*. More specifically, the Patent Office alleges that:

Dussere discloses the method as claimed with the exception of the providing a second pacifier in a smaller size. *Stevens* discloses that it was known to provide different sized pacifiers to users of different ages.

Independent Claim 43, as amended, requires the step of providing a first pacifier sized to be worn in the mouth of the user at the first age wherein the first pacifier has a first shelf and a first ring attached to a first shield. Independent 43 requires that the second length of the second shelf is greater than the first length of the first shield and the second bulb of the second pacifier is a smaller bulb than the first bulb of the first pacifier.

Stevens merely teaches a endotracheal tube pacifier having a nipple portion, bite portion and flange portion. A slot is formed longitudinally along the length of the nipple portion, bite portion and flange portion of the endotracheal tube pacifier. The slot is configured to detachably receive the sidewalls of an endotracheal tube even when an extremity of the endotracheal tube has already been received within a patient's mouth. The endotracheal tube pacifier is intended to reduce the physical anomalies associated with prolonged endotracheal tube intubation and to promote the natural sucking and swallowing reflexes of an infant undergoing endotracheal intubation.

Neither *Dussere* nor *Stevens*, taken singly or in combination, teaches or suggests the step of providing a first pacifier sized to

be worn in the mouth of the user at the first age wherein the first pacifier has a first shelf and a first ring attached to a first shield as required by Claim 43. Further, either *Dussere* nor *Stevens*, taken singly or in combination, teaches or suggests that the second length of the second shelf is greater than the first length of the first shield and the second bulb of the second pacifier is a smaller bulb than the first bulb of the first pacifier as required by Claim 43.

Moreover, a person of ordinary skill in the art would never have been motivated to combine the teachings of *Dussere* with *Stevens* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Dussere* and *Stevens* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Dussere* and *Stevens* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the references still lack the novel features and the novel steps positively recited in independent Claim 43. Accordingly, Applicant asserts that the rejection of Claims 43-45 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 6, 8, 20, 29, 34 and 40 under 35 U.S.C. §103(a) as being unpatentable over *Dussere* in view of *Herbst*, Applicant respectfully submits that the rejection has been overcome by the amendment to independent Claims 1, 7, 21,

32 and 37 for the reasons that follow. Moreover specifically, the Patent Office asserts:

Dussere discloses the invention as claimed with the exception of the coolable liquid or gel. *Herbst* discloses placing a liquid or gel inside a pacifier.

Neither *Dussere* nor *Stevens*, taken singly or in combination, teaches or suggests the elements as required by independent Claims 1, 7, 21, 32 and 37 from which Claims 6, 8, 20, 29, 34 and 40 depend, respectively. In view of the foregoing, the rejection of Claims 6, 8, 20, 29, 34 and 40 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claim 18 under 35 U.S.C. §103(a) as being unpatentable over *Dussere* in view of *Tesler*, Applicant respectfully submits that the rejection has been overcome by the amendment to independent Claim 14 for the reasons that follow. Moreover specifically, the Patent Office asserts:

Dussere discloses the pacifier as claimed with the exception of the luminescent material. *Tesler* discloses such material for a pacifier.

Neither *Dussere* nor *Tesler*, taken singly or in combination, teaches or suggests the elements as required by independent Claim 14 from which Claim 18 depends, respectively. In view of the foregoing, the rejection of Claim 18 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claim 46 under 35 U.S.C. §103(a) as being unpatentable over *Dussere* in view of *Stevens* and further in view of *Herbst*, Applicant respectfully submits that the rejection has been overcome by the amendments to independent Claim 43 and for the reasons that follow. More specifically, the Patent Office asserts:

Dussere as modified by *Stevens* discloses the invention as claimed with the exception of the coolable liquid or gel. *Herbst* discloses placing a liquid or gel inside a pacifier.

None of *Dussere*, *Stevens* and *Herbst*, taken singly or in combination, teach or suggest the steps as required by independent Claim 43 from which Claim 46 depends. In view of the foregoing, the rejection of Claim 46 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-6 depend from Claim 1; Claims 8-13 depend from Claim 7; Claims 15-20 depend from Claim 14; Claims 22-31 depend from Claim 21; Claims 33-36 depend from Claim 32; Claims 38-42 depend from Claim 37; and Claims 44-46 depend from Claim 43. These claims are further believed allowable over the references of record, taken singly or in combination, for the same reasons set forth with respect to their parent claims since each sets forth additional novel features and steps of Applicant's pacifier and method for maintaining proper dentition in a mouth of a user.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are

in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 14, 2006.



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